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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,584	09/29/2003	Hiroshi Morikawa	243149US-2 CONT	9977
22850 7590 05/23/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER GRANT II, JEROME	
			ART UNIT 2625	PAPER NUMBER
			NOTIFICATION DATE 05/23/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

Application No.

10/671,584

Applicant(s)

MORIKAWA, HIROSHI

Examiner

Jerome Grant II

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 18-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 36-41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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### **Detailed Action**

1. The final rejection mailed February 5, 2007 is withdrawn. New art has been found.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 18-22, 24-27, 30-34, 42 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Kobayashi.

With respect to claim 18, Kobayashi teaches a method of printing data files using a printing device (see figure 1); comprising:

storing data files in work memory 16 which is associated with the printing device 1;  
selecting an arbitrary order (via UI processor 21 of para. 65); displaying a serial number (see the lower portion of figure 5 and para. 66; displaying a serial number, see figure 6a, indicating a printing order; and printing a plurality of data files printed in the selected order, see also page 6a.

With respect to claims 19, 25 and 31, see paragraph 66, lines 9-12.

With respect to claims 20, 26 and 32, Kobayashi teaches obtaining a plurality of files by scanning them from the input device 14 wherein the files correspond with image data, see para 66, lines 12-17.

With respect to claims 21, 27 and 33, Kobayashi teaches a first and second display means for the purpose claimed.

With respect to claims 22, 34, 42 and 43, Kobayashi teaches that a user may inter the items from the memory that are desired to be printed. The order of the print is not specific to the order that the information was stored. See the first 10 lines of paragraph 65.

With respect to claim 24, Kobayashi teaches a printing device according to figure 1 comprising:

storing data files in work memory 16 which is associated with the printing device 1;  
selecting an arbitrary order (via UI processor 21 of para. 65); displaying a serial number (see the lower portion of figure 5 and para. 66); displaying a serial number, see figure 6a, indicating a printing order; and printing a plurality of data files printed in the selected order, see also page 6a.

With respect to claim 30 Kobayashi teaches a computer program product via ROM36 for storing a computer program product for performing the steps of:  
:

storing data files in work memory 16 which is associated with the printing device 1;  
selecting an arbitrary order (via UI processor 21 of para. 65); displaying a serial number (see the lower portion of figure 5 and para. 66); displaying a serial number, see figure 6a, indicating a printing order; and printing a plurality of data files printed in the selected order, see also page 6a.

2.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi in view of HAM Van Oijen.

While Kobayashi teaches all of the subject matter upon which the claims depends, the reference does not teach using staples and paper punches.

However, Oijen teaches selecting at least one print condition including selecting at least one of stapling and punching, see col. 4, lines 43-58.

Since Kobayashi and Oijen are both directed toward printing devices and designating order of print jobs, the purpose of using staples and paper punches, would have been recognized by Kobayashi as set forth in Oijen.

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It would have been obvious to modify the control section 15 and the operation section 22 of Kobayashi for the purpose of adding the stapling and punching processes set forth by Oijen.

3.

**Claims Objected As Containing Allowable Matter**

Claims 36 – 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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4.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon.-Thurs. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles, can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jerome Grant II

